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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,829	01/12/2001	Stuart Berkowitz	668437600002	1904
7590	11/07/2005		EXAMINER	
John .v. Bienacki Jones, Day, Reavis & Pogue North Point 901 Lakeside Avenue Cleveland, OH 44114			RETTA, YEHDEGA	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/759,829

Applicant(s)

BERKOWITZ ET AL.

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/25/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Eldering (US 6,324,519).

Regarding claims 1-4, Eldering teaches receiving bids data from advertisement providers over a network, wherein an audio advertisement (see col. 1 lines 37-56, col. 4 lines 7-11) is played over the network if a bid data is determined satisfactory, receiving asking data over the network to determine whether the bid data is satisfactory (see col. 10 lines 29-64); determining whether the bid data is satisfactory and storing and playing an audio advertisement after the bid data is determined satisfactory (see abstract, col. 1 lines 37-56, col. 3 lines 1-55, col. 11 lines 37-47).

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Regarding claims 5-13, Eldering teaches storing a plurality of audio advertisements in a database; receiving a request to retrieve at least one of advertisements based upon predetermined selection rules; based on user profile; based on ad usage rules; based on profit rules (see fig. 6&7, col. 9 line 7 to col. 12 line 32; wherein the advertisement is played over the network to users of the telephony services; wherein the service is a voice markup language application located on the Internet (see col. 3 lines 1-55, col. 9 line 32 to col. 10 line 16); receiving ad usage data (see col. 4 lines 37-65, col. 8 lines 15-39).

Regarding claims 14-30, Eldering teaches a database that stores audio advertising data; an advertising retrieval server retrieves audio advertising data based upon predetermined selection rules (see col. 4 lines 36-54 and playing over a network to users of telephony services based upon the retrieved audio advertising data (see col. 3 lines 1-64); wherein the network is an Internet network (see fig. 1); an identifier that identifies an audio file containing an advertisement to be played (see col. 9 lines 1-67); a request to provide the advertisement to users of telephony services; retrieving the advertisement based on user profile (see fig. 7, col. 9 lines 32-49); usage rules to determine which ad to retrieve; receiving bid data from advertisement provider; receiving asking data to determined if the bid is satisfactory; (see fig. 7 and abstract, col. 1 lines 37-56, col. 3 lines 1-55, col. 4 lines 37-65, col. 8 lines 15-39, col. 10 lines 29-64).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

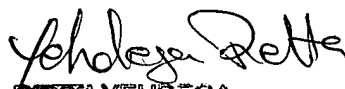
Kamel et al. (US 5,937,037) teaches comparing preset target criteria of audio advertising with profile data.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
RETTAYEHDEGA  
PRIMARY EXAMINER

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